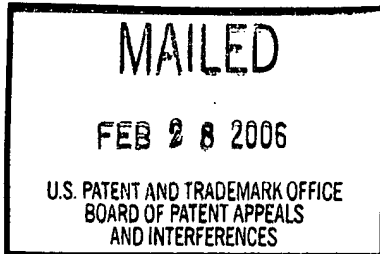


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY DWORKIN



Appeal No. 2005-1499
Application No. 09/589,266

ON BRIEF

Before FRANKFORT, McQUADE, and NAPPI, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Barry Dworkin appeals from the final rejection (mailed November 26, 2003) of claims 4-13, all of the claims pending in the application.

THE INVENTION

The invention relates to business and greeting cards bearing web-site promotional indicia, and to a method of using such cards to receive on-line vendor discounts. Representative claims 4, 7 and 9 read as follows:¹

¹ The preamble of claim 11, "[t]he multi-purpose card of claim 10," lacks a proper antecedent basis as claim 10 is drawn
(continued...)

4. A multi-purpose card, comprising:
a business card having issuing business or individual identifying indicia thereon;
multiple participating vendor web-site addresses printed on the business card;
vendor promotion discount indicia printed on the business card to be redeemed at the respective web-site addresses; and
a promotion code printed on the business card, whereby a holder of the business card is able to access a participating vendor web-site address printed on the business card, enter the promotion code at the web-site and receive the vendor promotion discount.

7. A multi-purpose card, comprising:
a greeting card having artwork and message indicia printed thereon;
multiple participating vendor web-site addresses printed on the greeting card;
vendor promotion discount indicia printed on the greeting card to be redeemed at the respective web-site addresses; and
a promotion code printed on the greeting card, whereby a holder of the greeting card is able to access the at least one web-site address of the at least one participating vendor, enter the promotion code at the web-site and receive the vendor promotion discount.

9. A method for encouraging retention of business or greeting cards and simultaneously increasing visits to participating web-sites, the method comprising the steps of:
providing a multi-purpose card in the form of business or a greeting card;
printing a list of participating vendor web-site addresses and associated promotional discount indicia on the business or greeting card;
printing a promotional code on the business or greeting card;

¹(...continued)
to "[t]he method of claim 9." This informality should be corrected in the event of further prosecution before the examiner.

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using a computer network to access a participating vendor web-site using the vendor web-site address printed on the business or greeting card; and
entering the promotional code on the business or greeting card at the web-site to obtain the promotional discount.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

King	5,922,427	Jul. 13, 1999
Rodriguez et al. (Rodriguez)	2003/0050961	Mar. 13, 2003
Rubstein et al. (Rubstein)	2003/0061566	Mar. 27, 2003

THE REJECTIONS

Claims 4-8 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 4-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodriguez in view of King and Rubstein.

Attention is directed to the brief (filed June 17, 2004) and answer (mailed September 9, 2004) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 101 rejection of claims 4-8

The examiner considers claims 4-8 to recite non-statutory subject matter because "[t]he claimed invention is directed to nonfunctional descriptive matter" (answer, page 3). By way of further explanation, the examiner adds that "[c]laims 4-8 . . . describe printed matter that is not functionally related to a computing process" (answer, page 5) and that "the subject card invention defined by claims 4-8 . . . merely records information, and does not produce a 'useful, concrete and tangible result.'" (answer, page 5).

35 U.S.C. § 101 provides that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Congress intended statutory subject matter under § 101 to include anything under the sun that is made by man. Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980). Nonetheless, § 101 has limits and does not embrace every discovery within its statutory terms. Excluded from patent protection are laws of nature, physical phenomena and abstract ideas. Diamond v. Diehr, 450 U.S. 175, 185 (1981). In applying

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these principles to determine the eligibility of a claim under § 101, the claim must be considered as a whole. Id., 450 U.S. at 188.

Appealed claims 4-8, considered as a whole, recite a multi-purpose card, not nonfunctional descriptive matter, printed matter or recorded information as alleged by the examiner. The claimed multi-purpose card is an article of manufacture which, on its face, falls within the "manufacture" category of § 101 and avoids the laws of nature, physical phenomena and abstract ideas exceptions. Hence, the examiner's position that claims 4-8 are drawn to non-statutory subject matter is unpersuasive.

Accordingly, we shall not sustain the standing 35 U.S.C. § 101 rejection of claims 4-8.

II. The 35 U.S.C. § 103(a) rejection of claims 4-13

Rodriguez, the examiner's primary reference, discloses a business card having the usual textual information which identifies a principal, address, phone, etc. (see paragraph 0004). The card also includes steganographically encoded multi-bit binary data which enables a computer to initiate a link to the principal's internet site whereby the recipient of the card can access the principal's schedule and other information that

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may change over time (see paragraph 0006). This other information can comprise promotional offers or advertisements relating to the principal's business or other businesses to whom the principal has rented screen space (see paragraph 0019). The encoded data on the card may embody authentication data necessary to gain access to an otherwise restricted site (see paragraph 0020). Rodriguez also teaches that the foregoing concepts may be applied to other printed documents such as calling cards (see paragraph 0022).

The examiner, apparently according patentable weight to the printed matter recitations in the appealed claims, concedes (see page 4 in the answer) that Rodriguez lacks response to the limitations in independent claims 4 and 7 requiring multiple participating vendor web-site addresses to be printed on the card, the limitation in independent claim 9 requiring a list of participating vendor web-site addresses to be printed on the card, and the limitations in claims 4, 7 and 9 requiring a promotion code to be printed on the card. To account for these shortcomings in Rodriguez, the examiner turns to King and Rubstein.

King discloses a packet for removing particulate matter such as lint, dandruff and hair from clothing. The packet comprises a

pad 34 of adhesive backed leaves 32 mounted within a protective cardboard cover 12. In use, one opens the cover, peels an adhesive leaf from the pad and applies it to clothing to take hold of and remove unwanted matter. King teaches that the protective cover may bear advertising messages to serve as a promotional tool and that the packet can be distributed as a complimentary token by hotels and other businesses (see, for example, column 2, lines 21, 22 and 48-60).

Rubstein discloses a process for dynamically integrating two or more digital files for on-line electronic delivery. The following passage from the reference fairly summarizes the teachings focused on by the examiner:

[0014] The present invention is directed to a process for dynamically integrating two or more digital files (that may be of different types, including but not limited to executable and non-executable files). In one embodiment of the present invention, an advertisement is dynamically integrated with a digital file. More specifically, an animated advertisement file is dynamically integrated with a self-contained executable file for an animated greeting card. The animation file for the advertisement may include graphics, video, audio and/or provisions for user interactivity. In another embodiment, a redeemable gift is dynamically attached to the digital file.

[0015] In another aspect of the present invention, a control feature is provided to

control the usage of the distributed digital file. In one embodiment, a unique code is generated and assigned to the distributed digital file. The unique code prevents the user from, for example, executing the digital file more than a predefined number of times. In a further aspect of the present invention, the control feature may be used for awarding prizes in connection with the distributed digital file.

In applying Rodriguez, King and Rubstein to reject independent claims 4, 7 and 9, the examiner submits that:

6. Rodriguez et al. does not teach multiple vendor addresses printed on the card. King teaches multiple advertisements printed on the card (col. 2 lines 50-52). Because King also suggests the use of said card by a hotel, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to advertise a host of hotel-related businesses on the card, such as shops in the hotel building and taxi companies, which reads on multiple participating vendor addresses. Further, because such cooperative advertising would promote all the participating businesses, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of King to those of Rodriguez et al.

7. Rodriguez et al. does not teach a promotion code printed on the card. Rubstein et al. teaches a game code (promotion code) printed on the card (para. [0055]). Because Rubstein et al. teaches that this provides security (the control feature), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the

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teachings of Rubstein et al. to those of
Rodriguez et al [answer, page 4].

In short, the only suggestion for this fanciful combination of the widely disparate teachings of Rodriguez, King and Rubstein stems from hindsight knowledge impermissibly derived from the appellant's disclosure. The rejection formulated by the examiner is further unsound as it rests on an erroneous finding (see pages 4 and 6 in the answer) that Rodriguez meets the limitations in claims 4, 7 and 9 requiring promotion discount indicia to be printed on the card. Although the Rodriguez reference discusses promotional offers which arguably encompass discounts, these offers appear on the principal's web-site, not on the business or calling card itself.

Thus, as applied by the examiner, the combined teachings of Rodriguez, King and Rubstein do not justify a conclusion that the differences between the subject matter recited in claims 4, 7 and 9 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of

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independent claims 4, 7 and 9, and dependent claims 5, 6, 8 and 10-13, as being unpatentable over Rodriguez in view of King and Rubstein.

III. Remand to the examiner

This application is remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) and MPEP 1211 for consideration of the following matter.

As discussed above, claims 4-8 recite a multi-purpose card which is defined by the matter printed thereon.

It is well settled that differences between an invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter. In re Lowry, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034; In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403 (Fed. Cir. 1983); In re Miller, 418 F.2d 1392, 1396, 164 USPQ 46, 49 (CCPA 1969). Where the printed matter is not functionally related to the substrate, however, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. What is required is the existence of differences between the claims and the prior art sufficient to

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establish patentability. Thus, the bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. In re Gulack, supra, 703 F.2d at 1385, 217 USPQ at 404. Also see In re Miller, supra, 418 F.2d at 1395-96, 164 USPQ at 48-49.

On remand, the examiner should reconsider the patentability of claims 4-8 over the prior art in light of these principles, and enter an appropriate rejection if such is deemed to be warranted.


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SUMMARY

The decision of the examiner to reject claims 4-13 is reversed, and the application is remanded to the examiner for further consideration.

REVERSED AND REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


ROBERT NAPPI
Administrative Patent Judge